

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Augustin J. Farrugia et al.

Application No.: 09/975,994

Filed: October 15, 2001

For: DEPLOYMENT OF SMART CARD
BASED APPLICATIONS VIA MOBILE
TERMINALS



MAIL STOP AMENDMENT

Group Art Unit: 2157

Examiner: Moustafa M. Meky

Confirmation No.: 9558

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 28, 2006, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-5 and 16-24. The continued indication that claims 6-15 and 25-33 are allowed is noted with appreciation.

The most recent Office Action maintains the rejections of claims 1-5 and 16-24 as being either anticipated by, or obvious over, the Sashihara patent. Claim 1 recites a smart card that provides a user with access to a smart-card based internet application in the absence of a conventional smart card reader. The claimed smart card contains two types of information. A first set of information enables a telecommunications device, with which the smart card is used, to establish a connection with a telecommunications network. The second set of information comprises an applet that enables the device to conduct an internet session with an internet-accessible application, once the connection is established. This applet functions as an interface to the application.

The Sashihara patent discloses a transmitting and receiving card that can be selectively attached to either a portable phone or an information terminal, such as a web browser terminal. The Office Action relies upon the embodiment illustrated in Figures 7 and 8 of the patent. As shown in Figure 8, the transmitting and receiving card 4 contains a card

physical layer 47, a network transport layer protocol 46, and an HTTP transmitting means

418. As pointed out in Applicants' previous responses, the contents of the card correspond, at best, to the second set of information recited in claim 1, namely an applet that enables the portable phone to conduct an internet session with an internet accessible application once a connection is established. It does not, however, contain the first set of information recited in claim 1, which "enables a telecommunications device... to establish a connection with a telecommunications network."

In rejecting the claim, and in responding to Applicants' previous arguments to this effect, the Office Action refers to the Sashihara patent at column 7, lines 65-67, and column 8, lines 7-15. It is respectfully submitted that these passages in the patent do not disclose, nor otherwise suggest, the claimed first set of information. Specifically, at column 8, lines 3-9, the patent states that, when a URL document is to be retrieved, "the HTTP transmitting section 418 *requests* the portable phone 3 to connect to the dial-up server 2." Thus, the transmitting and receiving card asks the *phone* to make the connection. This request is similar to a user manually pressing the "call" button on a phone. There is no disclosure in this passage, or elsewhere in the patent, which indicates that the transmitting and receiving card contains information which *enables* the phone to establish a connection with the dial-up server 2. Since the card merely sends a *request* to the phone to make the connection, the logical conclusion is that it is the phone, and not the card, which contains the information that enables the connection to be made.

Since the Sashihara patent does not disclose that the transmitting and receiving card contains information which enables a telecommunications device to establish a connection with a telecommunications network, it does not anticipate claim 1. If the rejection based upon the Sashihara patent is not withdrawn, the Examiner is requested to explain how the patent is being interpreted to disclose the claimed first set of information.

Claim 4 recites that the smart card is a subscriber identification module that authenticates a user to the network. The Office Action acknowledges that the Sashihara

patent does not disclose this claimed subject matter. It goes on to state that smart cards which include identification and/or personal information for a user are known, and concludes that it would be obvious to modify the transmitting and receiving card of the Sashihara patent to include such information. It is respectfully submitted that this conclusion is unsupported, and therefore does not meet the requirements for a prima facie case of obviousness.

While smart cards, and in particular SIM cards for authenticating users of portable telephones to networks are known, the Office Action has not identified any *reason* for including such functionality in the transmitting and receiving card of the Sashihara patent. As pointed out in Applicants' previous responses, the purpose of the card disclosed in the Sashihara patent is to enable the transmission and receipt of email to and from a server to be performed "without connecting the portable phone and the information terminal via a cable..." (column 1, lines 41-45). In essence, the transmitting and receiving card functions as a portable memory, which allows email to be transported between the email terminal and the portable phone without requiring a physical connection between them. Given this intended use, there is no reason to incorporate the functionality of a SIM card in the transmitting and receiving card of the Sashihara patent. The Office Action does not identify any teaching in the Sashihara patent that would motivate a person of ordinary skill in the art to do so. Furthermore, since the rejection is based only upon the Sashihara patent, the Office Action does not cite any other evidence that would provide the purported motivation.

As set forth in MPEP §2143, there are three requirements that must be met to establish a prima facie case of obviousness. The first of these is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. This section of the Manual goes on to state that such a teaching or suggestion "must ... be found in the prior art, not in Applicant's disclosure." The Office Action does not identify any teaching in the prior art which suggests the modification set forth in the Office Action. As such, the

contention of obviousness must be based upon knowledge of Applicants' disclosure, which does not form a proper basis for the rejection.

For at least the foregoing reasons, therefore, it is respectfully submitted that claims 1-5 are patentably distinct from the Sashihara patent. For at least these same reasons, claims 16-24 are also submitted to be patentable over the reference.


Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: September 28, 2006

By:



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Title: DEPLOYMENT OF SMART CARD
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AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☒ A Petition for Extension of Time is enclosed.
- ☐ _____ Terminal Disclaimer(s) and the ☐ \$ 65 ☐ \$ 130 fee per Disclaimer due under 37 C.F.R. § 1.20(d) are enclosed.
- ☐ Also enclosed is/are: _____
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$ 395 ☐ \$ 790 fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____ on _____ for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

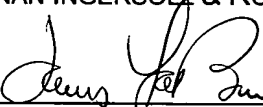
AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	33	33	0	x \$ 50 (1202)	\$ 0
Independent Claims	5	5	0	x \$ 200 (1201)	0
<input type="checkbox"/> If Amendment adds multiple dependent claims, add \$ 360 (1203)					\$ 0
Total Claim Amendment Fee					\$ 0
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					0
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0

- ☐ Charge _____ to Deposit Account No. 02-4800 for the fee due.
- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to credit card for the fee due. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date September 28, 2006

By: 
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